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EXAMINER

GENCO, BRIAN C

ART UNIT PAPER NUMBER

2615

DATE MAILED: 11/21/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/614,919

Applicant(s)

SAKAMOTO ET AL.

Examiner

Brian C Genco

Art Unit

2615

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-10 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 1-10 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on ____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on ____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. ____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) ____.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). ____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

Drawings

The drawings are objected to as failing to comply with 37 CFR 1.84(p)(4) because reference character "28" in Fig. 1 has been used to designate both left and right microphones. Similarly reference characters "30, 34, 36, 60, 62, 66, and 68" in Fig. 1 refer to similar components on parallel paths. A proposed drawing correction or corrected drawings are required in reply to the Office action to avoid abandonment of the application. The objection to the drawings will not be held in abeyance.

In step S100 of Fig. 2 Examiner suggests changing the word "regeneratidn" to "regeneration".

The drawings are objected to under 37 CFR 1.83(a) because they fail to show in Fig. 2 the step of waiting for the depression of a "REGENERATION BUTTON" between steps S100 and S102 as described in the specification on page 9, lines 18-20. Any structural detail that is essential for a proper understanding of the disclosed invention should be shown in the drawing. MPEP § 608.02(d). A proposed drawing correction or corrected drawings are required in reply to the Office action to avoid abandonment of the application. The objection to the drawings will not be held in abeyance.

In step S140 of Fig. 3 Examiner suggests changing the word "truck" to "track".

In step S216 of Fig. 5 Examiner suggests changing the word "ivt" to "itt" as described in the specification on page 15, line 26.

In Fig. 5 the label for step S180 is confusing, namely stating to select an image number, implying that a specific image is being designated, however in the description of Fig. 5 it is

readily apparent that the number T is merely the number of images a user wishes to display, not a particular image designated by the user.

Examiner notes that in step S200 it is labeled to "START AUDIO REGENERATION FROM AUDIO TAG 3 IVT1". Based on the description of the specification on page 15, lines 13-23 Examiner believes that this should be changed so that the start of audio regeneration begins at audio tag 3 – ivt1 as depicted in Fig. 4.

Fig. 8 is confusing because there are multiple images titled Image2. Further, the last two images have Audio Tag2=8, however they are listed under track 9. Further, Audio Tag4 in all of the images doesn't seem meaningful. Still further, it is not clear why the audio tracks skip from track 5 to track 9 and why there is overlap in displaying the second image between track 5 and track 9. Fig. 8 does not match the description on page 19, line 20 – page 23, line 6 and does not correlate to the flow diagrams of Figs. 9 and 10.

The drawings are objected to as failing to comply with 37 CFR 1.84(p)(4) because reference character "S280" in Figs. 9 and 10 has been used to designate both the last step shown in Fig. 9 and a first step shown in Fig. 10 and described on page 21, lines 22-27. A proposed drawing correction or corrected drawings are required in reply to the Office action to avoid abandonment of the application. The objection to the drawings will not be held in abeyance.

Specification

Examiner suggests changing the word "processes" to "processed" on page 8, line 22.

Examiner suggests changing the word "S1*2," to "S182," on page 14, line 11.

Examiner notes the description of Fig. 5 is confusing. On page 14, lines 9-12 it is implied that a user specifies specific images displayed on a preview screen that are to be regenerated. In the following description it is apparent that a user is merely selecting a number of images to be regenerated, and not specific images. See page 16, lines 8-14 in particular.

Claim Rejections - 35 USC § 112

Claims 4 and 7-10 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

In regards to claim 4 Examiner notes the limitation wherein “the regeneration of the sound in accordance with the audio regeneration data starts from the elapsed time” is not described anywhere in the specification. Examiner notes that there is description of the regeneration of the image in accordance with the audio regeneration data starts from the elapsed time.

In regards to claim 7 Examiner notes that there is no description in the specification that discloses that the first and second recording mediums as claimed in claim 3 are the same. Examiner notes that while there is description of Fig. 1 disclosing the ability to additionally record audio data through microphones 28 and to subsequently play back that audio recording with the regeneration of the corresponding image, as described on page 23, lines 13-16, there is no description that the first recording medium, namely the one regenerating sound, and the

second recording medium, namely the one that captures an image or reproduces the image in accordance with the regenerated sound, being the same. In clearer terms of the Applicant's disclosure the first recording medium is the audio CD and the regenerated sound is the regeneration of the audio CD using the external regeneration device 70. The second recording medium is recording medium 42 of Fig. 1. Note that there is no disclosure that recording medium 42 regenerates the audio data of the audio CD in the regeneration device 70.

Claims 8-10 depend from claim 7.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Claim 3 is rejected under 35 U.S.C. 102(e) as being anticipated by (US PG-PUB 2002/0054218 A1 to KOBAYASHI et al.).

In regards to claim 3 Kobayashi discloses a recording and regenerating method of an electronic camera, comprising the steps of:

regenerating sound in accordance with audio data which is recorded in a first record medium (e.g., element 132 of Fig. 2 wherein the first record medium is an implied part of element 132);

recording image data representing a subject in a second record medium at image-capturing, and recording, in the second record medium, audio regeneration data which indicates where the sound is stored at the image capturing (e.g., second record medium is element 102 of Fig. 2; Figs. 3, 4, and 8; paragraphs 0052 and 0079);

regenerating an image in accordance with the image data recorded in the second record medium, and regenerating the sound at the image-capturing in accordance with the audio regeneration data which is recorded together with the image data and also in accordance with the audio data which is recorded in the first record medium (e.g., paragraph 0079, wherein the recorded audio data in the memory card is reproduced in accordance with the audio data which is recorded in the first record medium, namely it is identical to it).

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

Claims 1 and 2 are rejected under 35 U.S.C. 103(a) as being unpatentable over (US PG-PUB 2002/0054218 A1 to KOBAYASHI et al.).

In regards to claim 1 KOBAYASHI et al., herein Kobayashi, discloses an electronic camera, comprising:

- an imaging part which captures a subject image (e.g., element 122 of Fig. 2);
- a record medium which records captured image data (e.g., element 102 of Fig. 2); and
- at least one of an audio regeneration device which regenerates sound and a communication device which communicates with an external device which performs audio regeneration (e.g., element 132 of Fig. 2; elements 103, 108, and 109 of Fig. 1),

wherein when the subject image is captured, audio regeneration data which at least indicates where the sound during audio regeneration is stored is recorded in the record medium together with the captured image data (e.g., Figs. 3, 4, and 8; paragraph 0052).

Examiner notes that in Fig. 1 the digital still camera 101 and the image handler 103 are disclosed as separate devices wherein they are connected through placing the memory card 102 in each of the respective devices. Therefore it would have been obvious to one of ordinary skill

in the art at the time of the invention to have made the digital still camera 101 and the image handler 103 an integral device, since it has been held that forming in one piece an article which has formerly been formed in two pieces and put together involves only routine skill in the art.

Howard v. Detroit Stove Works, 150 U.S. 164 (1893).

In regards to claim 2 Kobayashi discloses an electronic camera, comprising:
an imaging part which captures a subject image (e.g., element 122 of Fig. 2);
a record medium which records captured image data (e.g., element 102 of Fig. 2); and
at least one of a display which displays an image in accordance with the image data recorded in the record medium and an image signal output device which externally outputs an image signal in accordance with the image data recorded in the record medium (e.g., display device element 158 of Fig. 4 and output device elements 159 and 164 of Fig. 4; and

at least one of an audio regeneration device which regenerates sound and a communication device which communicates with an external device which performs audio regeneration (e.g., element 132 of Fig. 2; elements 103, 108, and 109 of Fig. 1),

wherein the image data and the audio regeneration data recorded in the record medium are read out, and the image is displayed in accordance with the image data while regenerating sound at image-capturing in accordance with the audio regeneration data (e.g., Figs. 3, 4, and 8; paragraphs 0052 and 0079).

Examiner notes that in Fig. 1 the digital still camera 101 and the image handler 103 are disclosed as separate devices wherein they are connected through placing the memory card 102 in each of the respective devices. Therefore it would have been obvious to one of ordinary skill in the art at the time of the invention to have made the digital still camera 101 and the image

handler 103 an integral device, since it has been held that forming in one piece an article which has formerly been formed in two pieces and put together involves only routine skill in the art.

Howard v. Detroit Stove Works, 150 U.S. 164 (1893).

Claims 3-10 are rejected under 35 U.S.C. 103(a) as being unpatentable over (USPN 5,812,736 to Anderson) in view of (US PG-PUB 2002/0054218 A1 to KOBAYASHI et al.).

In regards to claim 3 Anderson discloses a recording and regenerating method of an electronic camera comprising the steps of:

recording image data representing a subject in a second record medium at image-capturing, and recording, in the second record medium, audio regeneration data which indicates where the sound is stored at the image capturing (e.g., column 5, lines 41-51 and 55-58; Fig. 5);

regenerating an image in accordance with the image data recorded in the second record medium, and regenerating the sound at the image-capturing in accordance with the audio regeneration data which is recorded together with the image data and also in accordance with the audio data (e.g., column 6, lines 6-15; Fig. 6).

Anderson does not disclose that the audio data is regenerated in accordance with audio recorded in a first recording medium and that in regenerating an image it is regenerated in accordance with the audio data which is recorded in the first recording medium. Examiner notes that in Andersons description it is implied that the audio is input through a microphone in order to capture ambient audio data (column 6, lines 16-37). Kobayashi discloses that input audio data can be input from either a microphone or an input terminal 132, wherein the first recording medium is implied with the input terminal 132 (paragraph 0046). Therefore it would have been

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obvious to one of ordinary skill in the art at the time of the invention to have added an external audio input terminal in order to enable a user to alternatively supply audio data through a microphone or other audio input device if necessary. As such, audio data is regenerated in accordance with the first recording medium and is stored in the second recording medium along with the image data and the audio regeneration data. Upon regeneration of the image, audio data is regenerated from the second recording medium in accordance with the audio data in the first recording medium, namely they are identical audio data.

In regards to claim 4 Anderson discloses the recording and regenerating method of the electronic camera as defined in claim 3, wherein:

the audio regeneration data includes an elapsed time between a start point of the regenerating of the sound and a point of the image-capturing (e.g., As see in Fig. 5 there is an elapsed time between the start of regenerating sound and a point of image-capturing, namely 1.3 seconds, wherein that audio tag is the audio regeneration data; column 5, lines 20-58; Fig. 5); and

the regenerating of the sound in accordance with the audio regeneration data starts from the elapsed time (e.g., Anderson discloses that the regeneration of the sound starts at the beginning of the audio track wherein that is 1.3 seconds from the elapsed time; column 6, lines 6-15; Fig. 6).

In regards to claim 5 see Examiners notes on the rejection of claim 4. Note that the elapsed time is again 1.3 seconds for the first image, 3.8 seconds for the second image, and 4.9 seconds for the third image wherein, as described above, the audio regeneration starts at a predetermined time before the elapsed time, namely the audio starts 1.3 seconds before the first

elapsed time, etc. Examiner notes that Anderson discloses that the regeneration of the image starts at the elapsed time (column 6, lines 6-15; Fig. 6).

In regards to claim 6 see Examiners notes on the rejection of claims 4 and 5. Note that the order of regeneration is implied in the Anderson reference in that as shown in Fig. 6 the images are reproduced in time order, namely the first image is displayed first, etc. As disclosed by Anderson the sound data inherently is time-based and therefore has a order of regeneration based on that time and is therefore regenerated based on that order of regeneration (column 5, lines 37-38).

In regards to claim 7 Kobayashi discloses that a memory card can be loaded into element 108 of Fig. 2 wherein sound can be reproduced as with a magnetic disk, cassette tape, or the like (paragraph 0041). This teaches that audio can be reproduced through a memory card. Therefore it would have been obvious to one of ordinary skill in the art at the time of the invention to have made the implied recording medium of element 132 to have been a memory card in order to enable audio reproduction in a wide variety of devices as implicitly taught by Kobayashi (e.g., Fig. 2). As such, the first and second recording mediums would be identical, namely they would both be memory cards. Note that Anderson implicitly discloses using a memory card, element 354 of Fig. 3.

In regards to claims 8-10 see Examiners notes on the rejections of claims 4-6.

Claim 5 is rejected under 35 U.S.C. 103(a) as being unpatentable over (US PG-PUB 2002/0054218 A1 to KOBAYASHI et al.) in view of (USPN 5,220,433 to Mogamiya et al.).

In regards to claim 5 Kobayashi does not disclose nor preclude anything about elapsed times.

Examiner notes that it is extremely well known in the art to provide a series of still images to a display in order to easily review a plurality of the images previously recorded. Official notice is taken. Therefore it would have been obvious at the time of the invention to have reviewed a plurality of still images recorded by Kobayashi's invention in series in order to easily review a plurality of images.

As such, Mogamiya discloses to provide a fade in and fade out operation on still images and sound upon reproduction in order to avoid switches in images and sound that are unnatural to a user (e.g., column 1, lines 40-42; column 7, lines 4-68). Therefore it would have been obvious to one of ordinary skill in the art at the time of the invention to have provided a fade in and fade out operation on still images and sound upon reproduction in order to avoid switches in images and sound that are unnatural to a user. Mogamiya further discloses that the fading of one of the image or the sound can be delayed (e.g., column 10, lines 39-42). Therefore it would have been obvious to one of ordinary skill in the art at the time of the invention to have provided a delay between fading in the sound and fading in the image as suggested by Mogamiya.

As such, the above combination discloses the audio regeneration data includes an elapsed time from a start point of the regeneration of the sound (e.g., the elapsed time between beginning regeneration of the sound and the image);

the regenerating of the sound in accordance with the audio regeneration data starts at a predetermined time before the elapsed time;

the regenerating of the image starts at the elapsed time (e.g., the sound fades in first, then after an elapsed time the image fades in).

Claim 6 is rejected under 35 U.S.C. 103(a) as being unpatentable over (US PG-PUB 2002/0054218 A1 to KOBAYASHI et al.) in view of (USPN 5,220,433 to Mogamiya et al.) in further view of (USPN 5,657,074 to Ishibe et al.).

In regards to claim 6 it is implied with providing a series of still images that there is an order of regeneration.

Ishibe et al., herein Ishibe, discloses regenerating sound successively following an order of regeneration, namely providing a plurality of music tracks to choose from and associating the tracks with the images to be reproduced and simultaneously switching the music and the images according to the order (e.g., column 3, lines 11-56; column 6, lines 9-13; column 9, line 58 – column 10, line 22). Therefore it would have been obvious to one of ordinary skill in the art at the time of the invention to have associated specific sounds, namely ones of music tracks, with the images in order to have a more interesting presentation of still images. Examiner notes that in Mogamiya's disclosure there is set a time in which it is determined how long each image is to be displayed (e.g., column 7, lines 19-29). Ishibe further discloses setting an amount of time to display a certain image based on the number of music tracks selected (e.g., column 6, lines 15-59). Examiner notes that the elapsed time is the fade in time from the start of a new music track, namely every time a music track changes there the image changes as well.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Brian C. Genco who can be reached by phone at 703-305-7881 or by fax at 703-746-8325. The examiner can normally be reached on Monday thru Thursday 7:30am to 4:30 pm and every other Friday 7:30am to 3:30pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Andrew Christensen can be reached on 703-308-9644. The fax phone number for the organization where this application or proceeding is assigned is (703) 872-9306.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the customer service office whose telephone number is 703-308-4357.

Brian C Genco
Examiner
Art Unit 2615

November 3, 2003

A handwritten signature in black ink, appearing to read 'Andrew Christensen', with a long horizontal flourish extending to the right.

ANDREW CHRISTENSEN
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 2600